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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/086,526	03/04/2002	Takayoshi Kawai	112100	1085

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EXAMINER

JOHNSON, RAYMOND B

ART UNIT	PAPER NUMBER
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3652

DATE MAILED: 06/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

Applicant(s)

10/086,526

et al
Takayoshi KAWAI

Examiner

Art Unit

Johnson, R. B.

3652

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01/02/04.
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☒ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s) 284
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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OFFICE ACTION

1. The documents submitted in the IDS papers nos 2 and 4 have been considered.
2. Applicants election of species B shown in Figs 9-14 (described on pages 52-73 of the specification) with traverse is noted. The traverse is void of merit because of at least: a) applicants have clearly identified the two designated "embodiment" /species A and B (see page 17, lines 4-9 and the paragraph bridging pages 17-18); and b) applicants have failed to assert the two designated species are not patentably distinct. The species restriction requirement is deemed proper and is maintained, subject to rejoinder if a generic claim is found allowable.

- 3a. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- 3b. Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are written in a catalog type narrative form. It is not clear how any of the recited indicators or sensors in the claims are operative to perform any mechanical, electrical, chemical or physical function relative to any of the recited apparatus in the APPARATUS (feeds, support etc.) claims (1-16).

Further, it is not clear what structure claims 2, 4 and 6-8 is/are directed to. The "said" numerated "modes" in claims 7 and 10 lack both antecedent basis and apparatus function in the disclosure. From the examples recited it is clear the claims do not define the invention in the manner required by the statute.

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4. In so far as the claim(s) are definite and understood, the following rejections on the prior art are being rendered. The applied references may, but not necessarily; respond to the indefinite and/or inadequate disclosure matters noted. Such matters will not be specifically addressed in the rejections.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
6. Claims 1-16 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over either Yokoyama et al or Aguayo et al (IDS).

Structure wise it does not appear the claims define over any multi-stage automated manufacturing apparatus such as disclosed by either Yokoyama et al or Aguayo et al. However, if the claims are interpreted as requiring some manual step in lieu of the disclosed machine automated in the applied references then it is submitted it would have been obvious to replaced an automated mechanical operation/step with a manual step because this doctrine is well established.

7. Applicants remarks regarding the readability of the claims relative to the designated species are noted. It appears that applicants contend that claims 1-16 are readable on species B and claim 1-7 and 11-16 are generic to both species. Thus, it appears that applicants consider claims 8-10 to be limited to species B. Such a position is clearly untenable. Claim 8 does not define ANY additional structure relative to claim 1. Thus, it would not, arguably, appear that claim 1 or any claim dependent therefrom would be generic relative to species A and B.

8. Bailey et al disclose an automated inspecting and sorting apparatus.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to R.B. Johnson whose telephone number is (703) 308-2565. The examiner can normally be reached on Monday thru Thursday from 6:30-9:30 A.M. to 5:00-8:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, E.D. Lillis, can be reached on (703) 308-3248. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



EILEEN D. LILLIS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

Johnson/vs
March 25, 2004